

REMARKS

The present Amendment is in response to the Examiner's first Office Action mailed September 8, 2004. Claim 18 is amended to correct a typographical error, and new claims 35-38 are added. Claims 1-38 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. PRIOR ART REJECTIONS

A. Rejection Under 35 U.S.C. §102(b)

The Examiner rejects claims 1-3, 6, 11, 13-15, 28 and 33 under 35 U.S.C. § 102(b) as being anticipated by *Nakatsu, et al* (United States Patent No. 5,031,991). Because *Nakatsu* does not teach or suggest each and every element of the rejected claims, Applicant respectfully traverses this rejection in view of the following remarks.

As seen in FIGs. 3(a), 3(b), and 3(c), *Nakatsu, et al.* teaches an optical coupling circuit having two or more lenses. FIGs. 3(b) and 3(c) represent the same overall system as FIG. 3(a), wherein lens 10 is composed of lenses 1 and 3, and lens 20 is composed of lenses 2 and 4 (col. 5, ln. 52-54). FIG. 3(b) depicts the horizontal plane, and FIG. 3(c) represents the vertical plane (col. 5, ln. 54-55, 67-68). "[L]ens 3 is a cylindrical lens, and functions as a convex lens *only* in a direction perpendicular to . . . the semiconductor . . . , but *does not* function in a direction parallel

to the semiconductor.” (col. 5, ln. 31-35 (emphasis added)). As illustrated in FIG. 3(a), the solid line (representing the vertical plane) changes direction at lens 3, and the dotted line (representing the horizontal plane) is unaffected by lens 3, indicating different optical focusing powers in the vertical and horizontal planes. Therefore, lens 10, which is composed of lenses 1 and 3, has different optical focusing powers in the vertical and horizontal planes.

In direct contrast, the rejected claims specifically recite a first lens (referred to by the Examiner as lens 10 in the *Nakatsu* patent), “having a first optical focusing power in *both the first and second planes* of beam propagation.” (Applicant’s independent claims 1, 13, and 23 (emphasis added)). As further explained in the specification, “[t]he first focusing element 12 is a symmetrical focusing lens, which means it has the same focal length F_1 (*i.e.*, same optical focusing power) in both the vertical and horizontal planes of beam propagation.” ¶ 023. Therefore, independent claims 1, 13, and 23 are markedly distinct from the device taught in *Nakatsu*, which includes lens 10, having different optical focusing powers in the vertical and horizontal planes.

Since *Nakatsu, et al.* does not teach the device being claimed in this application, Applicant respectfully requests that the rejection under 35 U.S.C. § 102(b) be withdrawn.

B. Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 4-5, 16-17 and 26-27 under 35 U.S.C. § 103 as being unpatentable over *Nakatsu, et al.* (U.S. Patent No. 5,031,991) in view of *Pillai* (U.S. Patent No. 6,212,216). The Examiner also rejects claims 4-5, 16-17 and 26-27 under 35 U.S.C. § 103 as being unpatentable over *Nakatsu* in view of *Anthon* (U.S. Patent No. 6,125,222).

Applicant traverses the Examiner’s rejection for obviousness on the grounds that the references – either individually or in combination – fail to teach or suggest each and every element of the rejected claims. As described above, *Nakatsu* fails to teach a first lens having the same optical focusing power in both the vertical and horizontal planes of beam propagation, and *Pillai* and *Anthon* fail to satisfy this deficiency. In view of *Pillai*’s and *Anthon*’s failure to teach a first lens having the same optical focusing power in both the vertical and horizontal planes of

beam propagation, Applicant submits that the Examiner has failed to set forth a *prima facie* case for obviousness and respectfully requests that the rejection be withdrawn.

II. Allowed Subject Matter

The Examiner has indicated that claims 7-10, 18-21 and 29-32 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In light of the above arguments, Applicant respectfully requests that the objection be withdrawn, since the objected-to claims depend from an allowable claim.

CONCLUSION

In view of the foregoing, Applicant believes the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 8th day of February, 2005.

Respectfully submitted,



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